

The Examiner in the original paragraph pages 15 and 16 of the Office Action concludes erroneously that the Declaration is insufficient to overcome the rejection of the claims over *Dykhoff*. The Examiner is respectfully requested to reconsider the supporting Exhibits in their totality and withdraw the rejection of the claims over *Dykhoff*.

Rejection of Claims in view of *Close over Landin*. The Examiner has rejected Claims 23-27, 37-38 and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Close* in view of *Landin*. The Examiner argues that “*Close* disclosed the gaskets 70' may be formed from a single sheet 98, and sheet 98 having fire retardant properties (column 5, Lines 15-45)”. The cited passage, however, does not disclose the claimed fire resistant insulative material. The gasket of *Close* is plastic! Plastics are not fire resistant insulative materials. The gasket of *Close* is employed to prevent air infiltration and, as such, prevent cool air from flowing into the room (col. 3, ll. 55-59). Col. 5, ll. 41-45 states that the plastic material forming sheet 98 may exhibit fire retardant properties.

The Examiner then relies upon *Landin* to cure the deficiencies of *Close*. *Landin* merely discloses intumescent materials such as graphite. It is unclear why one of skill in the art would substitute such intumescent materials for the “spongy, compressible, sealing gaskets or thin non-compressible but flexible gasket” (col. 1, ll. 65-68) of *Close*. This is especially true since the plastic gaskets of *Close* are used to prevent air infiltration and thus cool air into the room. This is not the objective of the intumescent materials of *Landin*.

In any event, *Close* fails to disclose the methodology that is the crux of Applicant's invention. The compromised barrier of Applicants' claims has a certain fire rating from one area on one side of the barrier to another area on another side of the barrier. The present invention is directed to a method of correcting the defect (loss of fire rating) in the compromised barrier. The Examiner argues that “the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” (P. 18, ¶ E.) The “suggestion” of combining the references must be evident from the references themselves. There is no suggestion in the references that they be combined. No motivation exists as to why one would have combined the references especially since *Close* does not disclose the use of such thermal insulating materials to assist compromised barriers such as in the reestablishment of fire ratings.

Examiner's Rejection of the Claims Under the Second Paragraph of 35 U.S.C. § 112. The Examiner has maintained the rejection of Claims 23-27 under the second paragraph of 35 U.S.C. § 112. In maintaining the rejection of the claims under 35 U.S.C § 112, the Examiner fails to

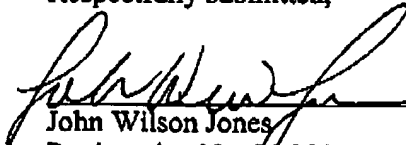
address the issues raised by Applicants in the previously filed Response. The claims state that the process is capable of "at least partially reestablishing a fire rating of barrier," i.e., partially or fully reestablishing a fire rating of 1, 2, 3, or 4 hours. The issue is whether one of skill in the art would understand what is meant by "at least partially reestablishing a fire rating of the barrier." One of skill in the art would recognize that barriers typically exhibit maximum fire rating of 1, 2, 3, or 4 hours. A 4-hour maximum rated barrier having gaskets rated for 2 hours would only be capable of partially reestablishing the fire rated barrier (for 2 hours). A 2-hour maximum rated barrier having gaskets rated for 2 hours would be capable of completely reestablishing its fire rating. Thus, the claimed terminology of "at least partially reestablishing a fire rating of the barrier" is not indefinite to those of skill in the art.

The Examiner argues that the claimed terminology "is confusing and unclear in light of the specification. What is at least partially reestablishing a fire rating of the barrier?" (P. 16 ¶ B). The issue of 35 U.S.C. 112, ¶1 is whether enablement exists to "any person skill in the art to which it pertains or with which it is most nearly connected, to make and use the same...." Applicant has already provided to the Examiner articles which reference test methods of measuring fire resistive properties of assemblies used in buildings. One of skill in the art would readily recognize what is meant by reestablishing a fire rating of a barrier. The term "at least partially reestablishing" is neither confusing nor unclear.

Conclusion. The Examiner is respectfully requested to telephone the undersigned should he deem it prudent to expedite the prosecution of this application into a Notice of Allowance.


Respectfully submitted,

Dated: September 19, 2005


John Wilson Jones
Registration No. 31,380
JONES & SMITH, LLP
2777 Allen Parkway, Suite 800
Houston, Texas 77019
Telephone No.: (713) 528-0148
Facsimile No.: (713) 893-6076

CERTIFICATE OF TRANSMISSION, 37 C.F.R. § 1.6(d)

I hereby certify that this correspondence is being transmitted to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 via facsimile. 571 273-8300 on this 19th day of September, 2005.


John Wilson Jones